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EXAMINER	
BASEHOAR, ADAM L	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,753	CHAUCHARD ET AL.	
	Examiner	Art Unit	
	Adam L. Basehoar	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: The RCE filed 08/04/05.

2. Claims 15-17 have been added as necessitated by Amendment.

3. The rejection of claims 1-2, and 6-14 under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) have been withdrawn as necessitated by Amendment.

4. The rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) in further view of Kirkpatrick et al (US: 2001/0042022 11/15/01) has been withdrawn as necessitated by Amendment.

5. The rejection of claims 4-5 under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) further in view of Government Liaison Services, Inc "Basic Facts About Registering A Trademark", 07/02/98, pp. 1-8, http://web.archive.org/web/19980702050742/http://www.trademarkinfo.com/basic.html (Hereafter "Basic Facts") has been withdrawn as necessitated by Amendment.

6. Claims 1-17 are pending in the case. Claims 1 and 14 are independent claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "competent" in claims 1 and 14 is a relative term which renders the claim indefinite. The term "competent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-2, 6-14, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) in further in view of Tran (US-2001/0049707 12/06/01).

-In regard to independent claim 1, Berke teaches a process for registering a trademark by means of a local computer (Fig. 2: 4) connected to a remote computer (Fig. 2: 8) via a computer Internet network (Fig. 2: 6)(column 4, lines 58-65) performing the following steps in order:

entering the trademark (columns 3 & 4, 30-32 & 15-19);

selecting the products or "goods" to which the trademark applies (column 3, lines 30-32);

validating the entry and the selection (column 3, lines 32-36);

sending (storing) the validated entry and selection to the remote computer (column 3, lines 36-38) via the network (column 3, lines 19-25).

Berke also teaches wherein selecting the products or "goods" to which the trademark applies could be a list of registered synonyms for each product or a selecting from an accurate existing database such as Federally registered Trademarks or a list of Common Law trademarks (column 6, lines 43-57). Berke does not specifically teach wherein the selecting of products or "goods" was from at least one official class of products and services. Coakley teaches wherein International trademark classifications were known to classify trademark goods and services (Page 2: Paragraph 0015: "International trademark class 25 which is related to clothing"). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have used a official class of products and services, because Coakley teaches using the official class was an internationally recognized standard for classing products and services of a trademark (Page 2: Paragraph 0015) and would be an "accurate" database as described in Berke (column 6, lines 52-57).

Berke also does not teach wherein the registered trademark was to be filed at a competent administrative department. Tran teaches filing the trademark application (Page 10: Paragraph 0092) with a national patent office (Page 5: Paragraphs 0048-0049). It would have been obvious to one of ordinary skill in the art at the time of the invention for the system of Berke to have registered said trademark application with a national patent office, because Tran teaches that by filing with a national patent office said user can procure value property rights (Page 1: Paragraph 0004).

-In regard to dependent claim 2, Berke teaches wherein at step of storing the trademark and goods (column 3, lines 36-38) at the remote server computer (Fig. 2: 8) was implemented through cooperation between the local (Fig. 2: 4) and remote computer (Fig. 2: 8) via entering and sending the information between the two computers over the network.

-In regard to dependent claims 6 and 7, Berke teaches selecting the products or "goods" to which the trademark applies could be a list of registered synonyms for each product or a selecting from an accurate existing database such as Federally registered Trademarks or a list of Common Law trademarks (column 6, lines 43-57). Berke does not specifically teach choosing a heading of at least one official class of products or services or choosing a number of an official class and displaying a corresponding number of the class or displaying a corresponding heading of the class respectively. As discussed above in regards to claim 1, Coakley teaches wherein International trademark classifications were known to classify trademark goods and services (Page 2: Paragraph 0015: "International trademark class 25 which is related to clothing"). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have used and displayed an official class of products and services and it's corresponding number, because Coakley teaches using the official class was an internationally recognized standard for classing products and services of a trademark (Page 2: Paragraph 0015: Class" "Clothing" Corresponding Number "25") and would be an "accurate" database as described in Berke (column 6, lines 52-57).

-In regard to dependent claim 8, Berke teaches:

entering at least one freely chosen wording (column 8, lines 6-7)(Fig. 5: 62);

Berke also teaches comparing said at least on freely chosen words with potentially synonymous wordings (column 7, lines 44-52). Berke does not teach comparing said chosen wording with the potential wordings contained in a file; displaying wordings proposed from among the potential wordings; selecting at least one wording from among the wordings proposed; and displaying the number of the official class corresponding to the wording selected. Coakley teaches comparing said chosen wording with the potential wordings contained in a file (Page 4: Paragraphs 0039-0040); displaying wordings proposed from among the potential wordings (Page 4: Paragraphs 0039-0040); selecting at least one wording from among the wordings proposed (Page 4: Paragraphs 0039-0040); and displaying the number of the official class corresponding to the wording selected (Page 4: Paragraphs 0039-0040). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have utilized the above features of Coakley, because Coakley teaches that said steps would provide the benefits of better locating trademarks (Page 4: Paragraph 0040) which would allow the trademark registration of Berke to better classify said trademark's goods and services.

-In regard to dependent claim 9, Berke does not teach wherein the file contains the wordings of the official classification of trademarks and the number of the class corresponding to each wording. Coakley teaches wherein the file contains the wordings of the official classification of trademarks and the number of the class corresponding to each wording (Page 3: Paragraph 0032 & Page 4: Paragraphs 0039-0040)(Fig. 3a: 32 & Fig. 3b: 179). As discussed

above, it would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have utilized the above features of Coakley, because Coakley teaches that said steps would provide the benefits of better locating trademarks (Page 4: Paragraph 0040) which would allow the trademark registration of Berke to better classify said trademark's goods and services.

-In regard to dependent claim 10, Berke does not teach wherein the file further includes additional wordings not featuring the official classification of trademarks and the number of the class corresponding to each of these additional wordings. Coakley teaches wherein the file further includes additional wordings not featuring the official classification (Fig. 3b: 179: "keywords")(Page 4, Paragraph 0040) of trademarks and the number of the class corresponding to each of these additional wordings (Page 4, Paragraph 0040). As discussed above, it would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have utilized the above features of Coakley, because Coakley teaches that said steps would provide the benefits of better locating trademarks (Page 4: Paragraph 0040) which would allow the trademark registration of Berke to better classify said trademark's goods and services.

-In regard to dependent claim 11, Berke teaches using comparison software permitting a display of proposed wording identical with the freely chosen wording (column 6, lines 45-57; column 7, lines 44-52).

-In regard to dependent claim 12, Berke teaches wherein the comparison permits the display of a proposed wording including the freely chosen wording (column 6, lines 43-51). In

addition, Coakley teaches displaying the proposed wording synonymous with the freely chosen word (Page 4, Paragraphs 0039-0040).

-In regard to dependent claim 13, Berke teaches wherein the software permits the display of a proposed wording synonymous with the freely chosen wording (column 6, lines 43-51). In addition, Coakley teaches displaying the proposed wording synonymous with the freely chosen word (Page 4, Paragraphs 0039-0040).

-In regard to independent claim 14, Berke teaches a local computer connected to a remote computer via a computer network including the following steps performed on the local computer:

entering a trademark (columns 3 & 4, 30-32 & 15-19);

entering at least one freely chosen wording for describing the products or services to which the trademark applies (columns 3 & 8, lines 30-32 & 6-7);

validating the entry and the selection (column 3, lines 32-36);

sending the validated entry and selection to a remote computer (column 3, lines 36-38) via the computer network (column 3, lines 19-25)(Fig. 1: 6).

Berke does not teach comparing said freely chosen wording with potential wordings contained in a file of at least one official class; displaying proposed wordings from among the potential wordings; selecting at least one wording from among the proposed wordings; displaying a number of the official class corresponding to the wordings selected. Coakley teaches comparing said freely chosen wording with potential wordings contained in a file of at

least one official class (Page 4: Paragraphs 0039-0040); displaying proposed wordings from among the potential wordings (Page 4: Paragraphs 0039-0040); selecting at least one wording from among the proposed wordings (Page 4: Paragraphs 0039-0040); displaying a number of the official class corresponding to the wordings selected (Page 4: Paragraphs 0039-0040)(Fig. 3b: 179). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have utilized the above features of Coakley, because Coakley teaches that said steps would provide the benefits of better locating trademarks (Page 4: Paragraph 0040) which would allow the trademark registration of Berke to better classify said trademark's goods and services.

Berke also does not teach wherein the registered trademark was to be filed at a competent administrative department. Tran teaches filing the trademark application (Page 10: Paragraph 0092) with a national patent office (Page 5: Paragraphs 0048-0049). It would have been obvious to one of ordinary skill in the art at the time of the invention for the system of Berke to have registered said trademark application with a national patent office, because Tran teaches that by filing with a national patent office said user can procure value property rights (Page 1: Paragraph 0004).

Berke also does not teach wherein all the steps were local to the computer (i.e. the validating step requires access the web based database). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have performed all the steps of the invention on a local computer, because it was notoriously well known at the time of the invention that performing actions local to a computer would reduce computation time by eliminating the need to communicate back and forth over a network with a remote computer/database.

-In regard to dependent claim 15, Berke does not teach wherein the remote computer (Fig. 2: 8) was disposed on a premises of an intellectual property attorney for reviewing the trademark registration application. Tran teaches providing intellectual property attorneys (Page 3: Paragraph 0034: "The Internet community 110....attorneys who can add value to the preparation") at a remote computer (Fig. 1: 110) for reviewing (Page 10: Paragraph 0090) trademark registration applications (Page 10: Paragraph 0092: "the system can process applications for copyrights and trademarks"). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have provided an offsite intellectual property attorney for reviewing the trademark application, because Tran teaches that said review enhances the member's work product (Page 10: Paragraph 0090) by taking advantage of the IP specialists experience to maximize the value of the intellectual property (Page 1: Paragraph 0006).

-In regard to dependent claim 16, Berke does not teach retransmitting the validated entry and selection from the premises of the attorney to another remote computer enabling the application to be prosecuted. As discussed above in the rejection of claim 15, Tran teaches the benefits of transmitting the trademark application to a IP attorney. Tran also teaches transmitting the trademark application to another computer for application prosecution (Page 5: Paragraphs 0048-0049). It would have been obvious to one of ordinary skill in the art for Berke to have had the trademark application sent from the reviewing IP attorney to another computer for prosecution, because Tran teaches said attorney's enhance the member's work product (Page 10:

Paragraph 0090) by taking advantage of the IP specialists experience to maximize the value of the intellectual property (Page 1: Paragraph 0006), and would thus provide the best chance of quick and successful prosecution of the application.

-In regard to dependent claim 17, Berke teaches transmission to the remote computer (Fig. 2: 8) of an identity of the trademark applicant (column 7, line 1: "registrant field"; column 7, lines 53-56) to complete the registration application file (i.e. "database record 44")

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) in further in view of Tran (US-2001/0049707 12/06/01) in further view of Kirkpatrick et al (US: 2001/0042022 11/15/01).

-In regard to dependent claim 3, Berke teaches validating the mark by checking the remote server computer if the combination of the mark and the goods associated with the mark were unique (column 3, lines 30-36), wherein once they were considered unique they were transmitted to the remote computer and stored (column 3, lines 36-38). Berke does not teach wherein the validated entry and selection are re-transmitted from the remote computer to another remote computer by electronic mail. Kirkpatrick et al teach sending an email notification (Fig. 1: 28a-b) of product registration from a remote computer (Fig. 1: 16) to another remote computer (Fig. 1: 18a-b)(pp. 3: Paragraph 0026). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have sent an email notification to another remote computer as shown in Kirkpatrick et al, because Kirkpatrick et al teaches that the second remote

computer may provide the local user computer the benefit of a verified acknowledgement that the registration process had been completed and accepted (pp. 3: Paragraph 0026).

12. Claims 4-5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berke (US: 6,629,092 09/30/03) in view of Coakley (US-2002/0194116 12/19/02) in further in view of Tran (US-2001/0049707 12/06/01) further in view of Government Liaison Services, Inc "Basic Facts About Registering A Trademark", 07/02/98, pp. 1-8, http://web.archive.org/web/19980702050742/http://www.trademarkinfo.com/basic.html (Hereafter "Basic Facts").

-In regard to dependent claim 4, Berke does not teach scanning in a model of the trademark. Coakley teaches wherein the trademark data structure containing information regarding a stored trademark include a model ("drawing") of the stylized mark (Page 3: Paragraph 0032). However Coakley does not teach scanning in a model of the trademark. Basic Facts teach wherein a model ("drawing") of the mark must be included in a registration application (Page 6: "Filling Requirements"). It would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have included a scanned model ("drawing") of the mark, because Basic Facts teach that all trademark registration application need a drawing of the mark of the application will not receive a filing data (Page 6: "Filling Requirements"). It also would have been provided the benefit of determining if the mark (i.e. when not just text based) was unique and thus available to be registered (column 7, lines 38-52).

-In regard to dependent claim 5, Berke teaches transmitting to a remote computer (column 3, lines 36-38) (Fig. 2: 8) the mark and the associated goods of the mark via a computer network (Fig. 1: 6). As discussed above in the rejection of claim 4, it would have been obvious to one of ordinary skill in the art at the time of the invention for Berke to have included a scanned model ("drawing") of the trademark with the mark and the goods and services, because Basic Facts teach that all trademark registration application need a drawing of the mark of the application will not receive a filing data (Page 6: "Filling Requirements"). It also would have been provided the benefit of determining if the mark (i.e. when not just text based) was unique and thus available to be registered (column 7, lines 38-52).

Response to Arguments

13. Applicant's arguments filed 08/04/05 have been fully considered but they are not persuasive.

In regard to independent claim 1, the Applicant argues the neither Berke or Coakley teach or suggest the newly amended limitations of preparing a trademark registration application "to be filed at a competent administrative department responsible for examining the application" (Remarks: Page 9: 2nd Paragraph). To expedite prosecution the Examiner has provided the Tran reference, as noted above, to teach the newly amended limitations. The Examiner notes, as shown by 112 rejection of the independent claims, that a "competent" administrative department is an indefinite limitation and the registering entity of Berke could be considered a "competent" department. Applicant is suggested to clearly point out in the claims what is meant by a "competent" department (i.e. a federally established Patent/Trademark Office). Applicant also

argues the motivation to combine the Berke and Coakley reference, supposing that associating the official class of products and services as taught by Coakley would further complicate the search engine of Berke by producing an increased number of resulting hits (Remarks: Pages 8-9). The Examiner respectfully disagrees with the Applicant. While the Examiner agrees that utilizing the official class would provide more hits for the search engine portion of the Berke reference, the Examiner believes said official classes would provide a more universal standard (i.e. accurate/uniform) database to be searched in reference to the trademark registering aspect of the Berke reference.

In regard to independent claim 14, the Applicant argues that neither Berke or Coakley teach or suggest the newly amended limitations as listed above. Please note the above paragraph in reference to said limitations. The Applicant also argues said references fail to teach "selecting at least one wording from among the proposed wordings." The Examiner respectfully disagrees with the Applicant. Coakley teaches (Fig. 3b) wherein a freely chosen wording (e.g. clothing) would display (i.e. through the Interrelated Classifications Table), the clothing class (i.e. I.C. 25), Related Classes (i.e. I.C. 26, I.C. 28, etc), and potential keyword wordings (i.e. Gloves). When selected said potential wordings would show a listing of related official classes (i.e. I.C. 28, I.C. 21).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-2003/0182141 09/2003 Wiedemann et al.

US-2004/0230449	11-2004	Franks, Robert
US-2004/0230550	11-2004	Simpson et al.
US-2005/0210009	09-2005	Tran, Bao

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB

STEPHEN HONG
SUPERVISORY PATENT EXAMINER